

REMARKS

Prior to this communication, claims 1, 2, 4 – 9, 19, 21 – 24, 26 – 40 are pending in the application. In the pending Office action, the Examiner finally rejected claims 1 – 9, and 19 – 40. In response, Applicants are submitting a Request for Continued Examination, amending claims 1 – 9, 19, 26, 28, and canceling claims 29 – 40; thus leaving claims 21 – 24, 27 unchanged. Reexamination and reconsideration in view of the amendment and remarks contained herein are respectfully requested.

Claim 26 stands objected for informalities. Claim 26 has been amended to dependent on claim 19.

Claims 1, 2, 4 – 6, 8, 9, 19, 21 – 24, 27 – 33, and 35 – 39 stand rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,172,428 (“Jordan”) in view of U.S. Patent No. 6,525,430 (“Asai”). Jordan discloses a digital control system (“DCS”) for monitoring the operation of a generator set (“gen-set”). The DCS includes a computer that is capable of graphically displaying and monitoring a plurality of measurements of analog characteristics of the gen-set. (Abstract, Jordan) Asai discloses an engine generator that includes a first outlet 45 for outputting a large alternating current, and a pair of second outlets 46 for outputting small alternating current that is smaller than the large alternating current. (Col. 4, lines 48 – 53, Asai) The Examiner asserted that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Jordan ’428 the digital control system for generator with a humanly perceptible indicator adapted to output plug as taught by Asai ’430 for the purpose of connecting the generator to the power source.” (Section 4, page 3 of pending action.)

To establish a *prima facie* case of obviousness, three basic criteria must be met. *M.P.E.P.* § 706.02(j), and 2143.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicant’s disclosure.

Id. See also In re Rougget, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (“To reject claims in an application under section 103, the Examiner must show an un rebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.”)

Amended claims 1 and 19 are repeated below for the Examiner’s reference.

1. A stand-alone detachable load monitoring module for use with a generator, wherein the generator is adapted to supply power to a load, the apparatus comprising:

a sensor adapted to sense a signal supplied to the load; and
a humanly perceptible indicator having a plug adapted to be inserted into a power receptacle, and to output at least one discontinuous humanly perceptible indication of the sensed signal supplied to the load.

19. A method of monitoring power supplied from a generator to a load with a stand-alone detachable humanly perceptible indicator, the method comprising:

inserting the stand-alone detachable humanly perceptible indicator into a power receptacle;

sensing the power supplied from the generator to the load; and
outputting at the humanly perceptible indicator at least one discontinuous humanly perceptible indication of the sensed power supplied to the load at the humanly perceptible indicator.

Applicants contend that the Examiner has not set forth a proper *prima facie* case of obviousness in section 4 of the pending action. For example, the Examiner must show that the prior art reference (or references when combined) teaches or suggests all the claim limitations. Firstly, amended claim 1 requires, among other things, a “stand-alone detachable load monitoring module,” and “a humanly perceptible indicator having a plug adapted to be inserted into a power receptacle, and to output at least one discontinuous humanly perceptible indication of the sensed signal supplied to the load.” Neither Jordan nor Asai teaches or suggests the humanly perceptible indicator having a plug adapted to be inserted into a power receptacle. Secondly, amended claim 19 requires, among other things, “inserting the stand-alone detachable humanly perceptible indicator into a power receptacle.” That is, claim 1 is directed to a stand-alone detachable load monitoring module, and claim 19 requires a stand-alone detachable humanly perceptible indicator. Both claims include a humanly perceptible indicator that has a plug, which can be adapted to be inserted into a power receptacle, among other things. Neither Jordan nor Asai teaches or suggests a humanly perceptible indicator that has a plug that can be inserted into a power receptacle. Therefore, neither Jordan nor Asai teaches or suggests all the limitations as claimed in claims 1 and 19.

Further, neither Jordan nor Asai suggests to combine the DCS disclosed in Jordan with a humanly perceptible indicator adapted to output as taught by Asai for the purpose of connecting the generator to the power source. Particularly, the operational panel 41 shown in FIG. 2 of Asai only includes elements such as an engine switch 42, an ignition control device 43, a battery charge outlet 44, a first outlet 45, a second outlet 46, a circuit breaker 47, a frequency switch 48, and a sticker 49. (FIG. 2, and Col. 4, lines 42 – 56.) Even if the frequency switch 48 is to be considered a humanly perceptible indicator or an output plug (and we do not), the frequency switch 48 is used to switch “to 50 or 60 Hz the frequencies of currents output from the first and second outlets 45, 46.” (Col. 4, lines 55 – 56.) Therefore, the frequency switch 48 does not “output at least one discontinues humanly perceptible indication of the sensed signal supplied to load,” or the frequency switch 48 cannot “be adapted to be inserted in power receptacle,” as claimed in claims 1 and 19. That is, none of the elements disclosed in Asai can be considered as a humanly perceptible indicator as asserted by the Examiner.

Furthermore, with respect to claim 1, *The Authoritative Dictionary of IEEE Standards Terms*, 7th Edition, page 783, defines the term “plug” as “a device, usually associated with a cord, that by insertion in a jack or receptacle establishes connection between a conductor or conductors associated with the plug and a conductor or conductors connected to the jack or receptacle.” Applicants, therefore, contend that Asai does not disclose any plug as defined above. Rather, Asai discloses a panel 41 that includes a plurality of electrical jacks or outlets 45, 46 into which a plug can be inserted. Specifically, Asai discloses that the panel 41 includes an engine switch 42, an ignition control device 43, a battery charge outlet 44, a first outlet 45, a second outlet 46, a circuit breaker 47, a frequency switch 48, and a sticker 49. (FIG. 2, and Col. 4, lines 42 – 56.) In other words, even if the control panel of Jordan is combined with the output ports (or outlets) for the purpose of connecting output power as disclosed by Asai, the combination of Jordan and Asai will not work as claimed in claim 1 because the control panel or the CIM 108 of Jordan does not contain a plug as defined by *The Authoritative Dictionary of IEEE Standards Terms*, and the outlets 45, 46 of Asai do not connect any output power to the control panel 300 or the CIM 108 of Jordan. Similarly, U.S. Patent No. 6,084,313 (“Frank”) discloses a generator with control panel 32b having a plurality of socket type outlets 32a, and therefore cannot be combined with the control panel of Jordan.

Still furthermore, the digital control system taught by Jordan includes a computer interface module (“CIM”) 330 that is embedded in a control panel 300. (Col. 10, lines 60 – 61) There is no teaching or suggestion that the control panel 300 can be inserted into any of

the outlets 45, 46 taught by Asai. Therefore, Applicants contend the Examiner has not set forth a proper *prima facie* case of obviousness in section 4 of the pending action. Therefore, claim 1 is allowable.

Before proceeding further, Applicants also note that the Jordan reference teaches away from claim 1 and teaches away from combining with other references to result in claim 1 since “CIM 108 is preferably integrated within the gen-set’s control panel.” (Col. 9, lines 35 – 40.) That is, the CIM 108 and the control panel are considered as an integrated unit, and therefore a power receptacle of the generator into which the CIM 108 is plugged is not required. Therefore, the Jordan reference explicitly teaches away from having “humanly perceptible indicator having a plug adapted to be inserted into a power receptacle, and to output at least one discontinuous humanly perceptible indication of the sensed signal supplied to the load.” Accordingly, independent claims 1 and 19 are allowable.

Still further, claim 1 requires a stand-alone detachable load monitoring module, while claim 19 requires a stand-alone detachable humanly perceptible indicator. Jordan does not teach or suggest that the digital control system (“DCS”), or the computer interface module 300 can be detached from the gen-set, or is a stand-alone module. Similarly, Asai does not teach or suggest that the panel 41 is a stand-alone module or can be detached from the generator 10. Similarly, Frank does not teach or suggest that the panel 32b is a stand-alone module that can be detached from the generator system 10. Accordingly, independent claims 1 and 19 are allowable.

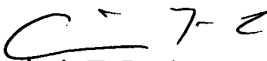
Claims 2 – 9, and 28, are dependent from claim 1. Accordingly, claims 2 – 9, and 28, include patentable subject matter for the reasons set forth above with respect to claim 1. Claims 21 – 24, and 27, are dependent from claim 19. Accordingly, claims 21 – 24, 26, and 27 include patentable subject matter for the reasons set forth above with respect to claim 19.

No new matter has been added.

CONCLUSION

Entry of the Amendment and allowance of claims 1 – 9, 19, 21 – 24, and 26 – 28 are respectfully requested. The undersigned is available for telephone consultation at any time during normal business hours.

Respectfully submitted,


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